

ESTTA Tracking number: **ESTTA676497**

Filing date: **06/05/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Shure Incorporated		
Entity	Corporation	Citizenship	Illinois
Address	5800 W Touhy Avenue Niles, IL 60714 UNITED STATES		
Attorney information	Katherine Laatsch Fink Banner & Witcoff Ltd. 10 S. Wacker Drive Suite 3000 Chicago, IL 60606 UNITED STATES bwptotm@bannerwitcoff.com, bwlitdocket@bannerwitcoff.com, pvanes@bannerwitcoff.com, kfink@bannerwitcoff.com, sdease@bannerwitcoff.com Phone:3124635000		

Applicant Information

Application No	79152375	Publication date	06/02/2015
Opposition Filing Date	06/05/2015	Opposition Period Ends	07/02/2015
International Registration No.	1216930	International Registration Date	05/22/2014
Applicant	Elvio Pugliese PO Box 1314 AUSTRALIA		

Goods/Services Affected by Opposition


Class 041. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Live music concerts; entertainment, namely, live music performances by musicians and musical groups; provision of entertainment facilities, namely, providing facilities for musical performances, providing facilities for recreational activities and providing general purpose pavilion facilities for concerts; arranging of music shows; arranging of musical entertainment events for entertainment purposes; music concert services, namely, arranging music concerts; music festival services, namely, organizing and arranging music festivals for cultural or entertainment purposes; music hall services; music performance services and musical performances, namely, live performances by musicians and musical groups; live band performances; night clubs; presentation of live show performances; production of live show performances

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	2163185	Application Date	05/20/1996
Registration Date	06/09/1998	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	The mark consists of a design of a microphone, specifically, the housing havingan arrangement of eight generally horizontal parallel slots around the middle portion of the housing and six generally vertical parallel slots on the top and bottom of the housing.		
Goods/Services	Class 009. First use: First Use: 1951/00/00 First Use In Commerce: 1951/00/00 microphones		

Attachments	75106877#TMSN.png(bytes) Notice of Opposition - Wireless.pdf(512491 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Katherine Laatsch Fink/
Name	Katherine Laatsch Fink
Date	06/05/2015

Attorney Docket:
010886.01673

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Applicant)	
Elvio Pugliese)	
)	
Mark: WIRELESS & Design)	
)	
Serial No.: 79/152,375)	
)	
Filed: May 22, 2014)	
)	
Published in the Official Gazette dated June 2, 2015)	
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SHURE INCORPORATED,)	
Opposer,)	
vs.)	Opposition No. _____
)	
ELVIO PUGLIESE,)	
Applicant.)	
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NOTICE OF OPPOSITION

Sir:

Opposer, Shure Incorporated, whose address is 5800 West Touhy Avenue, Niles, Illinois, 60714-4608, believes it will be damaged by registration of the above-identified mark (hereinafter “Applicant’s Mark”) and hereby opposes the same.

The grounds for the opposition are as follows:

1. Opposer is the owner of U.S. Trademark Registration No. 2,163,185, issued on June 9, 1998, for a mark consisting of “...a design of a microphone, specifically, the housing having an arrangement of eight generally horizontal parallel slots around the middle portion of the housing and six generally vertical parallel slots on the top and bottom of the housing.” A copy of Registration No. 2,163,185 is attached as Exhibit 1, and the mark as shown in the registration is as follows:

Reg. No. 2,163,185







2. The mark shown in Registration No. 2,163,185 (hereinafter the “55SH Design Mark” or “Opposer’s Mark”) is the configuration of goods known by Opposer’s trademark “55SH,” and said configuration mark has been in use continuously in interstate commerce since at least as early as 1951.

3. Shure has brought other successful oppositions based on the 55SH Design Mark, including the following:

	<p>SN 78440605 Opp. No. 91172313</p>
	<p>SN 76438405 Opp. No. 91157778</p>
	<p>SN 78802022 Opp. No. 91175285</p>
	<p>SN 78967404 Opp. No. 91179026</p>
	<p>SN 77145347 Opp. No. 91182265</p>
	<p>SN 77178685 Opp. No. 91182264</p>
	<p>SN 77352323 Opp. No. 91185874</p>

	<p>SN 78794202 Opp. No. 91187658</p>
	<p>SN 77759438 Opp. No. 91193922</p>
	<p>SN 85016660 Opp. No. 91196595</p>
	<p>SN 85033789 Opp. No. 91197079</p>
	<p>SN 85118278 Opp. No. 91200070</p>
	<p>SN 85009106 Opp. No. 91200695</p>

	<p>SN 85474646 Opp. No. 91204982</p>
	<p>SN 85551009 Opp. No. 91206540</p>
	<p>SN 85675053 Opp. No. 91208376</p>
	<p>SN 85356371 Opp. No. 91203951</p>
	<p>SN 85807737 Opp. No. 91211046</p>

	SN 85759290 Opp. No. 91212880
	SN 85850814 Opp. No. 91211903
	SN 86268453 Opp. No. 91218383
	SN 85841098 Opp. No. 91218551

Opposition Nos. 91172313, 91179026, 91182264, 91193922, and 91197079 were terminated with the voluntary withdrawal of the application by the Applicant; Opposition Nos. 91157778, 91175285, 91182265, 91185874, 91196595, 91200070, 91200695, 91204982, 91206540, 91208376, 91203951, 91211046, 91212880, 91211903, 91218383, and 91218551 resulted in decisions sustaining the oppositions; and Opposition No. 91187658 was terminated with the voluntary amendment of the application by the Applicant.

4. Applicant seeks to register a mark for a design that includes the design of a microphone that is virtually identical to Opposer's 55SH Design Mark. Applicant's Mark incorporates Opposer's registered 55SH Design Mark, without Opposer's permission, as shown below:

79/152,375



5. The opposed application, No. 79/152,375, was filed on May 22, 2014, pursuant to Section 66(a) of the Trademark Act.

6. Applicant seeks to register its mark for "Live music concerts; entertainment, namely, live music performances by musicians and musical groups; provision of entertainment facilities, namely, providing facilities for musical performances, providing facilities for recreational activities and providing general purpose pavilion facilities for concerts; arranging of music shows; arranging of musical entertainment events for entertainment purposes; music concert services, namely, arranging music concerts; music festival services, namely, organizing and arranging music festivals for cultural or entertainment purposes; music hall services; music performance services and musical performances, namely, live performances by musicians and

musical groups; live band performances; night clubs; presentation of live show performances; production of live show performances” in International Class 041.

7. Opposer’s 55SH Design Mark is known and widely used in the entertainment and music industry and widely recognized by the general public.

8. As a result of Opposer’s and its predecessors’ long use and registration of its 55SH Design Mark, Opposer has developed substantial goodwill in said mark, and the public has come to associate the 55SH Design Mark with the microphones of Opposer.

9. Applicant’s Mark, which contains a microphone that is virtually identical to Opposer’s registered 55SH Design Mark, so nearly resembles Opposer’s Mark, that when the mark is applied to the services identified in Applicant’s application in International Class 041, it is likely to be confused with Opposer’s Mark. Applicant’s Mark is deceptively similar to Opposer’s Mark, so as to cause confusion and to lead to deception as to the origin of Applicant’s services bearing Applicant’s Mark. As such, Applicant’s use and registration of its mark will inevitably lead to confusion, to mistake, or to deception of the public within the meaning of Section 2(d) of the Trademark Act of 1946, as amended, all to Opposer’s grave and irreparable damage.

10. As a further ground for opposition, Opposer’s registered 55SH Design Mark, which has been in use in commerce for more than fifty years, is famous within the meaning of Lanham Act Section 43(c), 15 USC 1125(c). Opposer’s Mark became famous prior to the filing date of the application for Applicant’s Mark and prior to any use of Applicant’s Mark. Applicant’s use of its mark, which incorporates Opposer’s famous mark in its entirety, causes dilution by lessening the capacity of Opposer’s Mark to identify and distinguish Opposer’s goods, in violation of Section 43(c), 15 USC 1125(c) of the Lanham Act.

11. If Applicant is permitted to register its mark, the registration would give Applicant a

prima facie exclusive right to the use of Applicant's Mark for the services set forth in the application. Such registration would damage and injure Opposer.

12. By reason of the foregoing, Applicant's registration of the design mark herein opposed will cause injury and damage to Opposer's rights to its registered 55SH Design Mark and to its use thereof described above.

WHEREFORE, Opposer respectfully prays that the present opposition be sustained and that the registration sought by the Applicant be refused.

Please charge the statutory fee of \$300 to our firm's deposit account, No. 19-0733. Please also charge any additional fees, or credit any overpayments, to our firm's deposit account, No. 19-0733.

Respectfully submitted,
BANNER & WITCOFF, LTD.
Attorneys for Opposer

Date: June 5, 2015

By: /Katherine Laatsch Fink/
Helen Hill Minsker
J. Pieter van Es
Katherine Laatsch Fink
10 South Wacker Drive, Suite 3000
Chicago, Illinois 60606
Telephone: 312-463-5000

Enclosure: Exhibit 1
Copy of Reg. No. 2,163,185

CERTIFICATE OF SERVICE

I hereby certify that on this 5th day of June 2015, a copy of the foregoing Notice of Opposition was served on the Applicant, by first class mail, postage prepaid, addressed as follows:

Mark My Words Trademark Services Pty Ltd
PO Box 1140
UPWEY VIC 3158
AUSTRALIA

/Katherine Laatsch Fink/

Exhibit 1

Int. Cl.: 9

Prior U.S. Cls.: 21, 23, 26, 36 and 38

Reg. No. 2,163,185

United States Patent and Trademark Office

Registered June 9, 1998

**TRADEMARK
PRINCIPAL REGISTER**



SHURE BROTHERS, INC. (ILLINOIS CORPORATION)
222 HARTREY AVENUE
EVANSTON, IL 602043696

FOR: MICROPHONES, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 0-0-1951; IN COMMERCE 0-0-1951.

THE LINING IN THE DRAWING IS USED TO INDICATE SHADING TO SHOW THE MARK IN THREE DIMENSIONAL FORM.

THE MARK CONSISTS OF A DESIGN OF A MICROPHONE, SPECIFICALLY, THE HOUS-

ING HAVING AN ARRANGEMENT OF EIGHT GENERALLY HORIZONTAL PARALLEL SLOTS AROUND THE MIDDLE PORTION OF THE HOUSING AND SIX GENERALLY VERTICAL PARALLEL SLOTS ON THE TOP AND BOTTOM OF THE HOUSING.

SEC. 2(F).

SER. NO. 75-106,877, FILED 5-20-1996.

ANDREW LAWRENCE, EXAMINING ATTORNEY